

REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1, 2, and 4 have been allowed. Claims 3, 5-7, 10, and 11 have been rejected as unpatentable over Ryan et al., US 5,285,795.

If a proposed modification of the prior art reference would change a principle of operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims obvious. MPEP §2143.01. Claims 3 and 5 recite a rotatable cutter. Ryan et al. disclose a probe (28) with a reciprocating cutter (40). The Office Action, page 2, states that it would have been obvious to one of ordinary skill in the art to replace the reciprocating cutter (40) with a rotatable cutter so that the modified cutter would not undergo abrupt changes in direction.

As is known in the surgical art, rotatable cutters also reciprocate about an axis in order to cut tissue. Thus, the motivation of avoiding abrupt changes in direction would not be present in this case.

Additionally, it is respectfully submitted that this modification would involve a substantial reconstruction and redesign of the probe (28) of Ryan et al. as well as change the basic principle under which the probe (28) was designed to operate. See MPEP §2143.01. A rotary drive arrangement is significantly different than a reciprocating drive. Claims 3 and 5 are in condition for allowance.

During patent prosecution, pending claims must be given their broadest reasonable interpretation. MPEP §2111. However, the broadest reasonable interpretation of the claims must also be consistent with the interpretation reached by one of ordinary skill in the art. MPEP §2111.

Claims 6, 7, 10, and 11 recite elongate elements (102, 104) which extend through the stem section (30) and the articulated section (34). The Office Action, page 3, states the combination of members (78, 102), as well as the unlabeled ring-shaped attachment member at the distal end (104) of the first and second elongate elements (94, 96) seen in Fig. 4 of Ryan et al. is considered to be the claimed "articulated section". The Office Action, page 3, further states that the elements (94, 96) extend through this artificially constructed combination that the Office Action names an "articulated section", since the elements (94, 96) are located radially within the confines of the outer diameter of the unlabeled ring-shaped attachment members.

Firstly, the unlabeled ring-shaped attachment members named by the Office Action are not described at all in the text of Ryan et al. and only appear in Fig. 4 as circles apparently in contact with the elements (94, 96) and the metal end (104). This type of hindsight manufacturing of an interpretation of Ryan et al. would not have been obvious to one of ordinary skill in the art with only Ryan et al. for guidance.

Secondly, the Office Action has compounded this strained interpretation of Ryan et al. by stating that the

elements (94, 96) somehow extend through these unlabeled and undefined ring-shaped attachment members. One of ordinary skill in the art would certainly not interpret the elements (94, 96) as "extending through" the artificially created combination of the bendable sections (78, 102), the metal end (104), and unlabeled ring-shaped attachment members (if this indeed is what these circles in Fig. 4 represent).

One of ordinary skill in the art might have considered the bendable sections (78, 102) to be articulated sections. The elements (94, 96) do not extend through the bendable sections (78, 102). Claims 6, 7, 10, and 11 are in condition for allowance.

Additionally, to further clarify this limitation in claims 3, 5-7, 10, and 11, these claims have been amended to include the actuator means/elongate elements extend through substantially the entire length of the articulated section (Aust et al., Col. 7, lines 56-67). This added language is a mere clarification of the already present limitation and does not require a further search or a burden on the Examiner.

Section 900 of the MPEP states that a careful and comprehensive search be made in preparing a first action on the merits. MPEP §904.03. It is not enough that references be selected to meet only the terms of the claims, but the search should also cover all subject matter which the Examiner reasonably anticipates might be incorporated into an amendment. MPEP §904.03. The first search should cover the invention as described and claimed, including inventive

concepts toward which the claims appear to be directed.

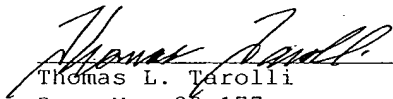
MPEP §904.

Thus, since the best reference that could be previously found by a careful, comprehensive, and reasonably anticipatory search is Ryan et al., it is respectfully submitted that a better reference should not, and does not, exist. Only an update of the previous search for newly issued patents is required.

In view of the foregoing, allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

  
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